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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,990	03/13/2000	Mou-Shiung Lin	MEG99-005	6138
28112	7590	10/20/2004	EXAMINER	
GEORGE O. SAILE & ASSOCIATES 28 DAVIS AVENUE POUGHKEEPSIE, NY 12603			WALSH, DANIEL I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AA

Office Action Summary	Application No.	Applicant(s)	
	09/523,990	LIN ET AL.	
	Examiner	Art Unit	
	Daniel I Walsh	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-23 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the response received on 28 July 2004.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 6, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Appropriate clarification/correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-10, 12-23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. (US 5,801,067).

Shaw et al. teaches forming internal marking indicia on a marking location on an exterior surface of the chip for identification, forming an optically transmissive encapsulating material over the marking location of the chip (abstract). As the protection layer covers the inked code, it is broadly interpreted as an encapsulating material, and as its part of the finished product, as discussed above, it is interpreted not to be removable/integral to the device without teaching away from or destroying the device. The material is transparent or semitransparent since it permits the code to be read, and that the protective layer protects against damage, as is well-known and conventional for protection layers. Re claims 4 and 8, radiation is directed upon the indicia to read it (abstract), as is well known and conventional in the art.

Re claims 6-7, the protective layer is understood to prevent remarking of the chip. It has been discussed in previous office Actions that the use of a transparent epoxy/resin as a protective layer is well known and conventional (see Tamaki for example). Using an epoxy/resin

protective layer is well known and conventional for producing expected results, and therefore is an obvious expedient.

Re claims 13-14 and 16-21 the limitations have been discussed above.

Re claims 5, 9-10, 12, 15, 22 and 23, the limitations have been discussed above, except for the cover layer/film being colored. Though the prior art of Shaw et al. is silent to the color of the cover/material, the Examiner notes that it is well known and conventional in the art to add additives or dyes to films/layers for reasons such as aesthetics, improved contrast, to reduce signs of wear, color matching, identification, etc. The Examiner notes that the step of changing the color of a coating is not patentable, and is an obvious modification to one of ordinary skill in the art, that is accomplished performing steps that are conventional in the art (dyes/additives).

4. Claims 5 and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al., further in view of Iwaya et al. (US 4,312,026).

The teachings of Shaw et al. have been discussed above, where the Examiner has asserted that simply changing the color of the layer is not a patentable step, since a change in color is obvious to one of ordinary skill in the art. However, the prior art is silent to identifying the chip based on the indicia and the color.

Iwaya et al. teaches that the colored protection layer of a capacitor can be used to provide identification of the capacitor in addition to indicia printed on it (in re FIG. 5-6).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Shaw et al. with those of Iwaya et al.

One would have been motivated to do this in order to have alternative ways to help identify the device.

Though Iwaya et al. is drawn to capacitors and not specifically IC chips, the Examiner notes that Iwaya et al. teaches supplemental (color) identification means provided on an electrical component. Simply extending the principle behind the identification (color and indicia) to an alternative electrical device would have been an obvious expedient, to one of ordinary skill in the art, to aid in identification purposes.

Additional Remarks

5. The Examiner notes that the protective coat taught by Shaw et al. indeed reads upon the claimed limitations of the rejected claims, as the protective layer is integral to the structure. Removal of the protective layer cannot be made without compromising the teachings of Shaw et al., if it can be removed at all. Therefore, since the layer is not designed to be removed (its specific purpose is to be present for protection), it is deemed unremovable (unscrapable), and accordingly is seen to read upon the claimed limitations. The applicant has not claimed a particular molecular structure or compound that is not able to be scraped off. The Examiner notes that even epoxy resin coatings (as suggested by the Applicant) can be "scrapped off", though doing so might compromise the device. Accordingly, the prior art of Shaw et al. is interpreted to read upon the claimed limitations, since removal may only occur if the teachings of the invention are destroyed, as such limitations teach away from the prior art. Further, if the Applicant wishes to claim a special protective layer/coating that exhibits such properties that it cannot be scraped off a surface no matter what, the Examiner suggests the specifics of the coating be incorporated into the claims so as to distinguish it from the prior art.

6. The Examiner has incorporated the new prior art to Shaw et al. for the rejection of the aforementioned claims. Any inconvenience is regretted.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Peterson (US 6,744,144), Takiar et al. (US 6,448,632), Kuczynski et al. (US 6,280,797), Grigg et al. (US 6,337,122), Peterson (US 2002/0076897), and Fujii et al. (US 5,218,192).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone numbers for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[daniel.walsh@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set for the in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

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D. Walsh

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



DW
10/15/04

Jared J. Fureman
JARED J. FUREMAN
PRIMARY EXAMINER